



AF/\$ 3728

PTO/SB/21 (08-03)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/892,527
	Filing Date	JUNE 28, 2001
	First Named Inventor	Stephane Grasso
	Art Unit	3728
	Examiner Name	Marie Patterson
Total Number of Pages in This Submission	Attorney Docket Number	Steph 01

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance communication to Group
<input checked="" type="checkbox"/> Fee Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment/Reply	<input type="checkbox"/> Petition	<input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Change of Correspondence Address	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> CD, Number of CD(s) _____	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	Three copies of brief filed herewith.	

TECHNOLOGY CENTER R3700

RECEIVED

FEB 02 2004

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Fred Grasso
Signature	<i>[Signature]</i>
Date	JAN. 25, 2004

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.	
Typed or printed name	Fred J. Grasso
Signature	<i>[Signature]</i>
Date	1/25/04

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PTO/SB/17 (10-03)

Approved for use through 07/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL**  
**for FY 2004**

Effective 10/01/2003. Patent fees are subject to annual revision.

☒ Applicant claims small entity status. See 37 CFR 1.27TOTAL AMOUNT OF PAYMENT (\$)**165****Compleat if Known**

Application Number	09/892,527
Filing Date	6/28/01
First Named Inventor	Stephanie Grosso
Examiner Name	Marie Patterson
Art Unit	3728
Attorney Docket No.	Stephol

TECHNOLOGY CENTER  
FEB 02 2004

RECEIVED

**METHOD OF PAYMENT (check all that apply)**☒ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None☐ Deposit Account:Deposit  
Account  
Number  
Deposit  
Account  
Name

The Director is authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Credit any overpayments☐ Charge any additional fee(s) or any underpayment of fee(s)☐ Charge fee(s) indicated below, except for the filing fee  
to the above-identified deposit account.**FEE CALCULATION****1. BASIC FILING FEE**

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	
SUBTOTAL (1)				(\$)	

**2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE**

		Extra Claims		Fee from below		Fee Paid
Total Claims	<input type="text"/>	-20** =	<input type="text"/>	X	<input type="text"/>	
Independent Claims	<input type="text"/>	-3** =	<input type="text"/>	X	<input type="text"/>	
Multiple Dependent					<input type="text"/>	

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	** Reissue independent claims over original patent
1205	18	2205	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2)

(\$)

\*\*or number previously paid, if greater; For Reissues, see above

**FEE CALCULATION (continued)****3. ADDITIONAL FEES**

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1051	130	2051	65	Surcharge - late filing fee or oath
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet
1053	130	1053	130	Non-English specification
1812	2,520	1812	2,520	For filing a request for ex parte reexamination
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action
1251	110	2251	55	Extension for reply within first month
1252	420	2252	210	Extension for reply within second month
1253	950	2253	475	Extension for reply within third month
1254	1,480	2254	740	Extension for reply within fourth month
1255	2,010	2255	1,005	Extension for reply within fifth month
1401	330	2401	165	Notice of Appeal
1402	330	2402	165	Filing a brief in support of an appeal
1403	290	2403	145	Request for oral hearing
1451	1,510	1451	1,510	Petition to institute a public use proceeding
1452	110	2452	55	Petition to revive - unavoidable
1453	1,330	2453	665	Petition to revive - unintentional
1501	1,330	2501	665	Utility issue fee (or reissue)
1502	480	2502	240	Design issue fee
1503	640	2503	320	Plant issue fee
1460	130	1460	130	Petitions to the Commissioner
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)
1806	180	1806	180	Submission of Information Disclosure Stmt
8021	40	8021	40	Recording each patent assignment per property (times number of properties)
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))
1801	770	2801	385	Request for Continued Examination (RCE)
1802	900	1802	900	Request for expedited examination of a design application

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**165**Fee Paid  
165

165

**SUBMITTED BY**

(Complete (if applicable))

Name (Print/Type)	Fred Grosso	Registration No. (Attorney/Agent)	43,644	Telephone	703 716 7372
Signature	<i>Fred Grosso</i>	Date	1/23/04		

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS.

**SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Steph 01  
09/892,527

20 # Brief  
E. Patten  
2/3/04

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

APPLICANT : Stephanie M. GRASSO  
SERIAL NO. : 09/892,527  
FILED : June 28, 2001  
FOR : SUPPLEMENTAL REMOVABLE OUTERSOLE FOR FOOTWEAR  
GROUP ART UNIT : 3728  
EXAMINER : Marie D. PATTERSON

M.S. Appeal Brief-Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

TECHNOLOGY CENTER R3700

FEB 02 2004

RECEIVED

**APPEAL BRIEF**

Appellant respectfully submits this Appeal Brief in support of her appeal from the August 28, 2003, final rejection and pursuant to the November 26, 2003, Notice of Appeal.

**Real Party in Interest**

The real party in interest is the inventor, Stephanie M. Grasso.

**Related Appeals and Interferences**

No other appeals or interferences are known to the Appellant or the Appellant's legal representatives involved in the prosecution of this application, which will directly affect or be

directly affected by or have a bearing on the Board's decision in this appeal.

#### Status of Claims

The Appellant appeals the rejection of claims 1-11 and 13-19.

Claim 12 was previously canceled without prejudice and is not being appealed.

The Appendix contains pending claims 1-11, and 13-19 as currently appealed.

#### Status of Amendments

The last entered claim amendments were filed on July 15, 2003, in the paper entitled "Response To April 4, 2003, Office Action." The last amendments to the specification were filed "After Final" on October 28, 2003, in the paper entitled "Amendment After Final / Request For Reconsideration In Response To August 28, 2003, Office Action." These amendments were entered by the November 7, 2003, Advisory Action.

#### Summary of Invention

The Appellant's application is generally directed to footwear systems and methods that employ a street worthy footcovering and a removable outersole having sport cleats. Throughout the pending claims the footcovering or sneaker is described as having bottom treads, i.e. it is street worthy or otherwise intended for use without the removable outersole. In each of the claims the removable outersole is described as having sport cleats projecting from its bottom surface. Accordingly, the rejected claims may generally be understood as regarding a shoe and outersole system or method that employs a shoe or sneaker for everyday wear and a removable outersole having sport cleats for selective attachment to the bottom of the shoe or sneaker.

Figures 1 and 2 of the specification and the accompanying text describe a variation of the invention employing a sneaker, first without and then with a supplementary outersole coupled to it. In Figure 1, an athletic footcovering 10 is illustrated along with a supplementary outersole 15. As described in the accompanying text, the athletic footcovering 10 has a rubber toe cap 13, a

rubber side molding 11, and a rubber bottom tread 12 suitable for everyday use. See Applic. at 3. As also described, Figures 1 and 2 contain a supplementary outersole 15 having a rigid plastic sole plate 17 and sport cleats 18 screwed to and protruding from the outersole 15. See Id.; see also as-filed claim 5. Containing a rigid plastic, the sole plate 17 increases the rigidity of the footwear, which has a rubber bottom tread, when the cleated outersole is secured to the footwear. The sole plate 17 is depicted in various figures including numbers 1 & 2 as patterning the size and shape of the bottom of the footwear 17 (or sneaker where applicable). In each case, the sole plate is in direct and continuous contact with the bottom tread of the footwear. See e.g., Applic. Figs. 1-5 and accompanying text.

#### Issues

Pending claims 1-11 and 13-19 are patentable over the cited references for numerous reasons. As explained below, the primary reference (Yavitz U.S. patent 5,600,902) cannot be supplemented as suggested in the Office Action because doing so would render it inoperable for its intended purpose, contradict the direct teachings of the reference, and ignore the requisite necessity for evidence providing a motivation to properly combine the cited references. For each of these reasons, all of the claims are patentable over the cited references. Claims 3-4, 7-11, and 18 are patentable over the cited references for other reasons as well. These reasons include the omission of certain claim language from the references cited against them and also for a lack of evidence justifying the combination of the additional patents cited in the Office Action.

#### Grouping of Claims

The entire group of appealed claims do not stand or fall together. Rather, for purposes of this appeal, claims 1-2, 5-6, 13-17 stand or fall as a group while claims 3; 4; 7; 8-11; and 18, which comprise five groups (e.g., 3; 8-11; etc.), may each stand based upon their dependency from an allowable independent claim as well as upon other reasons as well.

Argument

1. The Office Action's Redundant Modification Of Yavitz in View of Evans Renders Yavitz Unusable For Its Intended Purpose, Ignores Yavitz's Teaching Away, and Relies Upon Hindsight.

The Office Action modifies Yavitz (U.S. patent 5,600,902) in view of Evans (U.S. patent 6,032,386) in making its 35 U.S.C. § 103 rejection of independent claims 1 and 8 and adds a third reference Johnson (U.S. patent 4,327,503) in making its rejection of remaining independent claim 13. Despite these rejections, claims 1, 8, 13, and their dependent claims, are all patentable over these references as the Office Action has failed to make out a *prima facie* case of obviousness. If the Office Action's suggested modification was made, Yavitz would be rendered useless for its intended purpose - in fact, Yavitz expressly teaches away from the modification suggested by the Office action. Additionally, no other basis, other than improper hindsight, can explain the Office Action's redundant modification of Yavitz in view of Evans.

- a. The Primary Cited Patents - Yavitz, Evans, and Johnson.
  - i. U.S. Patent 5,600,902 to Yavitz

Yavitz is entitled "Removable Pads For Use With Spiked Golf Shoes To Protect Putting Greens." It regards a pad "designed for attachment to golf shoes to protect the surface integrity of putting greens on a golf course," see Yavitz Abstract (emphasis added). It does so by preventing the spikes of a golf shoe from "penetrating the surface of the green," see Yavitz Abstract (emphasis added).

The figures and supporting text of Yavitz provide for essentially two different types of removable pads. The first type ("type I") is seen in Figures 1-7 and is generally illustrated as being a flexible flat pad that would be secured to the bottom of a golf shoe to cover the spikes 20 of the golf shoe, and, thereby, prevent the spikes from penetrating the surface of a putting green. See, e.g., Yavitz Figs. 1-7 and accompanying text. A golfer may secure one of these pads to her shoe by simply placing the pad on the ground and then stepping onto it. See Yavitz col. 2, at 57-

60. Likewise, after the golfer walks off of the putting green, the pads may be manually removed by the golfer. See Yavitz col. 2 at 57-60. In some embodiments of type I the spikes penetrate directly into a mesh that forms the pad 10, see Yavitz Fig. 4, while in others the pad has pre-positioned recesses 46 that align with the spikes on the bottom of the golf shoe, see Yavitz Fig. 7. In each case, the pad is illustrated as being thicker than the length of the spikes.

The second type of pad in Yavitz (“type II”) is illustrated in Figures 8 and 9. Like type I, type II is intended to protect a putting green from a golf shoe’s spikes. See, e.g., Yavitz col. 3 ln. 47 - col. 4 ln. 16. In type II, however, the spikes 20 are not used to secure the putting “green protector” 52 to the golf shoe upper 14. Rather, a resilient portion or lip 60 is used to secure the putting green protector 52 to the golf shoe and, thereby, cover the spikes. See Yavitz Figs. 8-9. In order to protect putting greens from the spikes, the green protector 52 includes a stiffener layer 62. See Yavitz Fig. 9; col. 4 at lns. 4-11 (noting that stiffener layer 62 is “impenetrable by spikes”). The green protector 52 also includes a flat, uniform, and homogenous traction layer, which is “designed to provide the golfer with a more stable footing during putting,” see Id.

Notably, throughout Yavitz, both the pad and the green protector of type I and type II are illustrated as being generally planar and as spanning the non-planar arch of the illustrated golf shoes. Thus, neither the pad 10 nor the green protector 52 has the same dimensions as the sole of the golf shoes they are intended to interact with.

ii. U.S. Patent 6,032,386 To Evans.

Evans is entitled “Golf Shoe With Removable Sole” and generally regards a “sport shoe, particularly suitable for golf, [having] a base section sole and an overlying sole that is selectively removable from the base section sole.” See Evans Abstract. The base section sole of the shoe in Evans “can be spikeless, or include one type of spikes, while one or more overlying soles can include different spike types or spikeless faces.” See Id.

The exemplary embodiment of Fig. 5 in Evans shows two different overlying soles for attachment to the same shoe 20. The first overlying sole 70 is shown with a treaded bottom face

78 while the second overlying sole is shown with soft spikes 30 protruding from its lower surface. In each case both magnets placed in a well (no. 64) of the overlying sole and spikes from the golf shoe are used to collectively secure the overlying soles to the shoe. See, e.g., Evans Fig. 5 (showing magnets 62 and spikes 40); see also Evans Figs. 7 and 9 (showing a non-continuous magnetic sheet 132 having recesses 122 positioned to align with spikes 142 of the golf shoe). Evans teaches that the overlying soles should be flexible. This is made evident by the various wells 64 (Figs. 4-5), and ridges 99 (Figs. 6-7) of the overlying soles depicted in the figures. The text of Evans recognizes this feature when it discusses the well 64, noting that it “also serves to provide a thinner section area to enable the overlying sole to flex.” See Evans Col. 3 at 52-54; see also col. 5 at 18-22. The embodiments depicted in Figures 10-12 do not contain these ridges or wells. However, Evan does suggest that these embodiments should have ridges when it asserts that “flexing structures such as the ridges described above [99] can be provided to the overlying sole.” See Evans col. 6 at 49-51.

Nowhere in Evans, in its figures or specification, does it discuss or even suggest the use of an elastic band to secure the overlying sole to a golf shoe. Likewise, nowhere within Evans is a single rigid unhinged continuous plate placed within an overlying sole for attachment to a golf shoe.

iii. U.S. Patent 4,327,503 to Johnson.

Johnson is entitled “Outer Sole Structure For Athletic Shoe,” and regards the molded cleat structure of a permanent non-removable sole for an athletic shoe. See Johnson Abstract. Johnson does not regard any systems or methods that employ treaded footwear and removable outsoles as recited in the pending claims. Its simply regards a sneaker tread design that employs conical treads and cleats shaped in a partial frustum. See Johnson col. 3 at 27-40. As to the cleats that it does employ, Johnson recognizes that its large, sharp cornered cleats “will readily penetrate natural turf.” See Johnson col. 5 at 9-12.

b. The Office Action's Suggested Supplementation of Yavitz Renders It Inoperable For Its Intended Purpose.

The Office Action's rejection contravenes Federal Circuit precedent that holds "if references taken in combination would produce a 'seemingly inoperative device' ... such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness." See McGinley v. Franklin Sports, Inc., 262 F.3d 1339 (Fed. Cir. 2001) (citations omitted). Said another way, it is inappropriate to rely upon a reference in an obviousness analysis in a manner that would render the reference inoperable for its intended use. See In re Gordon, 733 F.2d 900 (Fed. Cir. 1984).

In the case of In re Gordon, the Federal Circuit reversed an obviousness rejection previously upheld by the Patent and Trademark Office Board of Appeals. In In re Gordon, the Appellant's claims to a blood filter assembly were rejected, predicated upon the Patent Office's redesign of a prior art strainer. See In re Gordon, 733 F.2d at 900. The Patent Office relied upon a single U.S. patent ("French") in rejecting the Appellant's claims. This reference regarded a liquid strainer for removing dirt and water from gasoline and other light oils. See Id. at 901. The reference disclosed a strainer having a fluid inlet and outlet at its top and internal helical threads within it. See Id. The reference further disclosed that the strainer relied upon "gravity [to] assist[s] in the separation of heavier oils or water." See Id. at 901-02. Comparatively, unlike the cited French strainer, the Appellant's filter permitted the entry and exit of blood from its bottom end. See Id.

In upholding the obviousness rejection, the Appeals Board opined that the Appellant's claims were unpatentable, reasoning that it would have been obvious to simply invert the French strainer, changing the location of the inlet and outlet from the top of the strainer to its bottom. The Federal Circuit disagreed, concluding that the correct inquiry should have been whether it would have been obvious for a fair reading of the prior art as a whole to turn the apparatus upside down. See Id. at 902. The Court found that French teaches a strainer that relies in part upon gravity to separate unwanted debris from gasoline and other light fluids. See Id. Due to its

reliance on gravity, the Court found that French would not have provided any motivation to one of skill to invert its strainer for upside down use. See Id. To do so, the Court found, would have “rendered [French] inoperable for its intended purpose ...[as] [t]he gasoline to be filtered would be trapped ... and the water ... would flow freely out of the outlet 5.” Id. In overturning the rejection, the Court then reasoned that rendering prior art inoperable for its intended purpose was tantamount to teaching away from the proposed modification and, as such, could not make out a *prima facie* case of obviousness. See Id.

The standing rejections of claims 1, 8, and 13 are equally flawed. Here, the Office Action does acknowledge that Yavitz fails to disclose or suggest placing sport cleats or turf knobs on the bottom of the green protector 52 of Figs. 8-9. The Office Action then attempts, however, to fill this void by suggesting a modification of Yavitz in light of Evans. The Office Action declares that Evans teaches “a removable outsole (28 or 160) ... comprising a plurality of cleats (30 or 204),” and then speculates that “it would have been obvious [to one of skill in the art] to ... provide a plurality of cleats as the traction means on the removable outsole as taught by Evans in the footwear system of Yavitz to provide a different style of sneaker and to provide increased traction, different levels of traction, or different types of traction.”

This argument fails. For one it ignores the entire purpose and function of Yavitz, to protect a putting green surface from spikes. In fact it exactly contravenes the purpose of Yavitz, as it suggests to add the very spikes that Yavitz is seeking to protect a putting green from.

Furthermore, to summarily conclude, as the Office Action does, that a motivation to increase traction or provide different levels or types of traction exists, this does not overcome the fact that the suggested motivation would render Yavitz useless.

The November 7, 2003 Advisory Action fails no better with its assertion that “the system of Yavitz would still function to protect putting greens, by providing shoes without cleats when the supplemental sole is removed.” In addition to providing no evidence, this argument also fails because each and every embodiment of Yavitz discloses and suggests that the golf shoes used in the systems of Yavitz have spikes. If spikes were not present in the type I systems of

Yavitz, as discussed above, there would be no way to attach the pads to the golf shoes. Likewise, the design of the type II systems also teaches that they should be used with spiked golf shoes. For example, the green protectors 52 have side walls sized to accommodate golf spikes and a stiffener layer 62 positioned to prevent the spikes from penetrating into a putting green. Thus, there is no evidence for reversing the spikes as suggested, instead the design and purpose of Yavitz teach against it.

c. Yavitz Explicitly Teaches Away From Adding Sport Cleats To The Bottom Surface Of Its Green Protector 52.

The Office Action's suggestion to add sport cleats to the bottom of the green protector 52 in Yavitz also contravenes Yavitz's direct teachings. It is well settled that it is impermissible to within the framework of section 103 to pick and choose from any one reference only so much as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986)(citations omitted). A useful general rule exists wherein "references that teach away cannot serve to create a prima facie case of obviousness." See McGinley v. Franklin Sports, Inc., 262 F.3d at 1354 (citations omitted). In fact the Federal Circuit has found that a teaching away can be the sole basis for defeating a contention of obviousness. See Winner International Royalty Corp. v. Wang, 202 F.3d 1340, 1349-50 (Fed. Cir. 2000).

Here, the Office Action has ignored Yavitz's teaching away from placing spikes or sport cleats on the bottom of the green protector 52. As described above, Yavitz teaches that sport cleats should not be placed on the bottom of the pads or green protectors disclosed therein. Yavitz's own summary begins by noting that it relates to devices that "prevent penetration of the green's surface by the golf shoe spikes during putting." See Yavitz col. 1 at 10-11. Yavitz likewise states that it would be "advantageous to provide an article ... that could temporarily be attached to the bottom of a regularly spiked shoe to prevent penetration of the spikes into the

green's surface.” See Yavitz col. 1 at 45-48. Accordingly, consistent with these teachings, the green protector 52 includes a stiffener layer that is impenetrable by spikes when stood on by a golfer. Therefore, the Office Action's contention of obviousness, which ignores Yavitz's explicit teaching away, must fail.

d. The Office Action Relies Upon Improper Hindsight When Suggesting Its Redundant Modification Of Yavitz In View Of Evans.

As a general matter, it is improper to pick and choose among the individual elements of assorted prior art references to recreate the claimed invention, rather one should look for some teaching or suggestion in the references to support their use in the particular claimed combination. See Symbol Technologies, Inc. v. Optican, Inc., 935 F.2d 1569 (Fed. Cir. 1991). More specifically, when considering the combination of references in an obviousness analysis, the Federal Circuit has cautioned that the best guardian against the subtle but powerful attraction of a hindsight based analysis is rigorous application of the showing of a teaching or motivation to combine prior art references. See In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999), limited on other grounds by In re Gartside, 203 F.3d 1305 (Fed. Cir. 2000). The Office Action has failed to make this showing.

The Office Action ostensibly argues that Yavitz shows a footwear system as substantially claimed in claims 1, 8, and 13 except for “the sole of the sneaker being planar and the exact traction means on the removable outsole.” The Office Action then attempts to fill this void by concluding that “Evans teaches ... a removable outsole (28 or 160) which has traction means comprising a plurality of cleats (30 or 204).” The Office Action then surmises that “it would have been obvious to provide a different known style of sneaker and to provide a plurality of cleats as the traction means on the removable outsole as taught by Evans in the footwear system of Yavitz to provide a different style of sneaker and to provide increased traction, different levels of traction, or different types of traction.” Thus, the Office Action provides no actual citation or other evidence in support of a motivation to combine Yavitz and Evans. It,

instead, provides only broad abstract statements regarding a new sneaker style and increased or different levels of traction as the justification for selectively combining these references. Based on this alone, the Office Action has failed to make out a *prima facie* case of obviousness.

Moreover, a careful analysis reveals that the true basis for the suggested combination must be hindsight. First, the Office Action's characterization of the traction layer 64 in Yavitz, as "a traction means," suggests that more has been read into Yavitz than is actually disclosed. The support layer 54 in Yavitz is illustrated as being a flat continuous piece of material that forms the resilient portion or lip 60, the support layer 54, and the traction layer 64 of the green protector 52. See Yavitz col. 4 at 5-16. This traction layer is both illustrated, see Fig. 9, and defined, see Yavitz col 4 at 5-6, as a flat bottom layer.<sup>1</sup> Thus, the applicable language and accompanying text for Figs. 8 and 9 do not suggest the use of various traction configurations or alternatives such as sport cleats, as suggested by Office Action's use of the word "means."

Next, both proposed motivations for combining Yavitz and Evans suggest the application of hindsight. The first, the suggestion of a desire for a new sneaker design, is so broad as to provide no real motivation at all. While the second, "to provide increased traction, different levels of traction, or different types of traction," actually positions the improper hindsight in sharper relief. This is because the traction layer 64 in Yavitz is described as being able to "provide the golfer with more stable footing during putting." Thus, Yavitz states that the provided traction layer is adequate or acceptable for providing traction, thus there would be no motivation to modify it. Said another way, Yavitz explicitly expresses that there is no need to modify its traction layer 64 for different types or levels of traction. Consequently, the fundamental impetus for the Office Action's articulated motivations must be the Appellant's disclosure.

Further evidence of hindsight exists in the notion that the Office Action is suggesting to

---

<sup>1</sup>Layer is defined in The American Heritage College Dictionary (3d ed. 1997) as: 2a. a single thickness of a material covering a surface or forming an overlying part or segment; 2b. a usually horizontal deposit or expanse; 2c. a depth or level.

make the green protector of Yavitz more complicated through the redundant addition of sport cleats. There is no evidence to support the premise that one of skill in the art would seek to add sport cleats to the bottom of the green protector 52 because the golf shoes to which they are to be attached already have spikes. Instead, it seems more plausible that one of skill would simply remove the overlying sole, as taught by Yavitz, in order to have spikes on the bottom of her feet.

Still further, the Office Action's suggested modification requires a complete redesign of Yavitz. This too cuts against its modification. Yavitz is the only reference that contains an elastic band as claimed. This band is used to position and secure the stiffener layer beneath the spikes, thereby preventing the spikes from penetrating the traction layer. There is no reason to believe that if Yavitz did not have spikes on the bottom of its shoes, as suggested by the Office Action, that Yavitz would even employ the elastic band shown in Fig. 9. Nowhere in the prior art is such a system disclosed and, absent the Appellant's disclosure, the Office Action would have no reason to suggest such a combination. Indeed, this is hindsight in its purest form.

e. The Rejected Claims Are Patentable, Even In The Light Of In re Epstein.

The Office Action's characterization of Appellant's arguments regarding the motivation to combine Yavitz and Evans as a "mere reversal of ... elements" and its citation to In re Epstein, 8 U.S.P.Q. 167 (C.C.P.A. 1931) is misplaced. The motivation for combining two references was not addressed in In re Epstein. Even if it were, it could not readily apply as the case predates the seminal Supreme Court decision in Graham v. John Deere, 383 U.S. 1 (1966).

In In re Epstein the Court considered whether it was obvious within one of the references to reverse the working elements of a device without changing the function of those elements. See In re Epstein 8 U.S.P.Q. at 167. In that instance, the Court concluded that it could. However, unlike In re Epstein the Office Action seeks to make changes between the references, something that In re Epstein does not address. Moreover, if the proffered changes were made, they would change how Yavitz functions, something that is not addressed in In re Epstein. Consequently, the Office Action's use and application of In re Epstein is erroneous.

2. Claims 3, 4, 7, 8-11, and 18 Are Patentable Over The Cited References For Other Reasons As Well.

a. As To Claim 3, There Is No Evidence Supporting The Proposed Motivation For Combining The Cited References And Even If There Were The Proposed Motivation Is Fatally Flawed.

The Office Action cites U.S. patent 4,525,939 to McNeil and U.S. patent 4,299,037 to Carey in combination with the references cited in rejecting claim 2 (Adair 3,643,352 and Smith 5,836,090) as its basis for a 35 U.S.C. § 103(a) rejection of claim 3. The Office Action provides no evidence for making the suggested combination but does, rather, make a sweeping conclusion that it would have been “obvious to form the cleats as turf knobs as taught by McNeil and/or Carey in the system of Yavitz ... to reduce the cost and weight of the outersole.” Thus, the Office Action argues that one of skill in the art, motivated by a desire to reduce the cost and weight of the Yavitz outersole, would have added the spikes of McNeil, *see, e.g.*, McNeil Fig. 1 at 16 and 18, or the cone shaped studs of Carey, *see e.g.*, Carey Fig. Fig. 4 at 46, to the traction surface of the green protector 52 of Yavitz.

This general overarching argument is mistaken. First, there is no evidence - only *arguendo* - that a motivation to reduce costs and weight exists. Such general conclusory statements are in and of themselves improper. *See In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (noting that broad conclusory statements standing alone to make a *prima facie* case of obviousness, are not evidence).

Second, even if such a motivation did exist, adding the spikes from McNeil or the studs of Carey to the green protector 52 of Yavitz would further complicate its design - raising its cost - and would increase its overall structure size - increasing its weight. Consequently, even if evidence were presented of a motivation predicated on reduced weight and costs, that motivation would not result in the suggested modification of Yavitz, because such a modification would complicate Yavitz's design - not reduce its cost - and increase Yavitz's mass - not reduce its weight.

- b. Claim 4 Is Patentable Also Because The References Fail To Disclose A Cleated Outsole System Having A Continuous, Rigid, Unbroken Sole Plate “Sized To The Same Dimensions As The Substantially Flat Treaded Bottom Of The Athletic Foot Covering.”

Claim 4 stands rejected under 35 U.S.C. 103(a) over Yavitz and Evans as applied to claim 1 and further in view of U.S. patent 4,377,042 to Bauer, U.S. patent 3,009,269 to Folk, or U.S. patent 5,615,495 to Mastrocola. Bauer is entitled “Footwear Having Removable Sole,” and generally regards unique individually designed uppers with removable outsoles. See Bauer Abstract. Folk is entitled “House Boot,” and generally regards a boot adapted to be removable secured to the lower portion of a shoe for preventing foreign material from soiling flooring or floor coverings. See Folk col. 1 at 7-12. Mastrocola is entitled “Insulating Sole Cover” and regards an insulating sole cover for a workboot to protect the workboot during extreme temperatures. See Mastrocola col. 1 at 5-10.

The Office Action does not address the language of claim 4 which recites “a sole plate ... having an exposed top surface ... being rigid, continuous, unbroken, and sized to the same dimensions as the substantially flat treaded bottom of the athletic foot covering.” Based on this alone, the rejection should be withdrawn.

Moreover, even if the cited references are considered, claim 4 is patentable over them. For one, none of these cited references disclose or suggest the system containing a rigid continuous sole plate having the same dimensions as the flat treaded bottom of the athletic foot covering as in claim 4. Bauer, Mastrocola, Folk, and Evan do not even contain a rigid continuous sole plate. As to Yavitz, it does not disclose a cleated outsole system with a rigid sole plate sized in the same dimensions as the footcovering for the system. As can be seen in Yavitz, the golf shoe contains a heel and an arch, so its bottom is not substantially planar as recited in claim 1. As the bottom of the shoe is not planar, it follows that the flat stiffener layer 62 from Yavitz does not have the same dimensions as the bottom of the shoe as recited in claim 4. In order to have the same dimensions, the stiffener layer would no longer be flat and would

need to conform with the arch portion of the golf shoe in Yavitz, which it does not. Consequently, Yavitz, like the other the cited references, fails to disclose the recited language.

c. Claim 7 Is Patentable For Several Reasons.

i. There Is No Real Motivation to Combine The References.

The Office Action fails to provide a sound motivation for combining the cited references in its rejection of claim 7. The Office action alleges that “it would have been obvious to use a cleat pattern as taught by Johnson in the system and inherent method of using a system of Yavitz as modified above to provide traction means/cleat pattern which is appropriate for both natural surfaces and artificial surfaces.” In other words, the Office Action is arguing that it would have been obvious to modify Yavitz with the spikes of Johnson in order to make Yavitz more suitable for both artificial and natural surfaces. This is flawed, however, as Yavitz regards golf shoes for golf, a sport played on natural grass. Consequently, there would be no motivation to make golf shoes more suitable for artificial turf, where golf is not played; as such, there is no plausible reason to combine the references.

ii. Even If The References Are Improperly Combined, They Nevertheless Fail To Disclose Or Suggest Sport Cleats “in the shape of a truncated cone ... hav[ing] at least two different heights relative to one another.”

The undersigned submits that the cited references fail to disclose or suggest a removable outersole system “wherein the sport cleats are in the shape of a truncated cone ... and have at least two different heights relative to one another,” as recited in claim 7. Even if Johnson is considered, which it should not be as it is not analogous art because it does not regard a removable outersole system, the spikes in Johnson are not truncated cones having two different heights as recited in the claim. Figures 1-3 of Johnson make this clear as they show the smaller cleats 32 being in the shape of full cones - not truncated cones as claimed - with rounded tips,

while the larger cleats are in the shape of a frustum - not cones at all. See also Johnson col. 3 at 27-40. Thus, claim 7 is patentable over, Yavitz, Evans, and Johnson for this shortcoming as well.

- d. Claims 8-11 Are Also Patentable Because The References Fail To Disclose An Athletic Footwear System Having “A Removable Outersole Having A Single Rigid Planar Unhinged Sole Plate ... The Sole Plate In Direct Contact With The Treaded External Sole Of The Sneaker.”

Various combinations of Yavitz, Evans, Adair, Smith, Johnson, Bauer, Folk, and Mastrocola are used to reject claims 8-11. However, claims 8-11 are patentable over each of the references as they each fail to disclose or suggest a rigid sole plate in direct contact with the treaded external sole of a sneaker as recited in claim 8. As to Yavitz, it is clear from Figures 8-9 that the stiffener layer 62 contacts the spikes 20 of the golf shoe, thus, Yavitz does not disclose this language. The other references are even further removed.

- e. The Rejection Of Claim 18 Fails For Several Reasons.
  - i. Improper Hindsight Is Used In Rejecting Claim 18 - The Reduction In Weight Supposition Provides No Design Motivation At All.

A combination of four patents was used to reject claim 18 (Yavitz, Evans, Johnson, and Wilcox). The Office Action makes this combination hypothesizing that “it would have been obvious to shape the cleats as taught by Wilcox in the system ... of Yavitz to provide a different design, to reduce the weight of the shoe.” As discussed above, this motivation fails because adding turf knobs or sport cleats to Yavitz would increase its weight and complexity.

- ii. Even If Improperly Combined, The References Fail To Disclose The Method of Claim 18 Wherein The Turf Knobs “are In The Shape Of A Truncated Cone Having ... At Least Two Different Heights Relative To Each Other.”

Consistent with the discussion of claim 7 and the lack of a compelling motivation for combining the references, claim 18 would also be patentable over the cited references as they each fail to disclose turf knobs "in the shape of a truncated cone having ... at least two different heights relative to each other," as recited in claim 18.

For the foregoing reasons, the Appellant respectfully submits that the rejections of the pending claims should be reversed.

Respectfully submitted,

Dated: January 25, 2004

By:

A handwritten signature in cursive script, appearing to read "F. Grasso", written over a horizontal line.

Fred T. Grasso

Reg. No. 43,644

2689 Mattox Creek Drive  
Oakton VA 22124  
703 716 7372

APPENDIX

1. (Previously Presented) A removable cleated outersole system comprising:
  - an athletic foot covering having a permanent substantially planar treaded bottom,
    - the treaded bottom having a toe portion, a heel portion, a perimeter side surface,
    - the perimeter side surface defining the perimeter shape of the permanent treaded bottom of the athletic foot covering;
  - a single elastically deformable band creating a continuous unbroken loop,
    - the band having an unbroken and continuous top edge and a bottom edge,
    - the bottom edge of the band being unbroken and formed in the shape of the perimeter shape of the permanent treaded bottom of the athletic foot covering;
  - a substantially planar unbroken sole surface coupled to the bottom edge of the band, the sole surface configured in the same perimeter shape and size of the permanent treaded bottom of the athletic foot covering, the sole surface sized to extend between the toe portion and the heel portion of the athletic foot covering,
    - the sole surface having a bottom side; and
  - a plurality of sport cleats protruding from the bottom side of the sole surface.
2. (Previously Presented) The removable cleated outersole system of claim 1 further comprising:
  - an anchoring strap having a first end and a second end,
    - the first end connected to the elastically deformable band,
    - the second end connected to the elastically deformable band,
  - the sole surface having a toe cap sized to cover the toe portion of the athletic foot covering; and
  - a rigid substantially planar continuous and unbroken sole plate coupled to and

supporting the sole surface, the sole plate formed in the same shape as the sole surface.

3. (Previously Presented) The removable cleated outersole system of claim 2 wherein the anchoring strap is releasably connected to the deformable band and wherein the plurality of sport cleats are turf knobs formed as part of the bottom side of the sole surface of the removable cleated outersole and wherein the sole plate is formed in the same size as the sole surface.
4. (Previously Presented) The removable cleated outersole system of claim 1 wherein the elastically deformable band has a tapered cross-section, is made with spandex rubber and is the sole means for attaching the outersole to the athletic foot covering and  
the sole surface containing a sole plate, the sole plate having an exposed top surface, the sole plate being rigid, continuous, unbroken, and sized to the same dimensions as the substantially flat treaded bottom of the athletic foot covering.
5. (Previously Presented) The removable cleated outersole system of claim 1 wherein the sole surface includes a rigid sole plate, the rigid sole plate being continuous and unbroken and sized to have the same perimeter shape and dimensions as the treaded bottom of the athletic foot covering.
6. (Previously Presented) The removable cleated outersole system of claim 5 wherein the sport cleats are one of a soccer cleat, a rugby cleat, a baseball spike, a football spike, and a track sprinter's spike.
7. (Previously Presented) The removable cleated outersole system of claim 5 wherein the sport cleats are in the shape of a truncated cone with conical sides and have at least two different heights relative to one another when measured from a bottom of the sole surface,

the heights of the sport cleats closer to the perimeter of the sole surface being relatively taller than the heights of the sport cleats near a center of the sole surface.

8. (Previously Presented) An athletic footwear system comprising:
  - a sneaker with a heel portion and a toe portion,
  - the sneaker having a permanent continuous treaded external sole with an outside perimeter edge,
  - the permanent treaded external sole being substantially planar;
  - a removable outersole having a single rigid planar unhinged sole plate, the sole plate being the same size and dimension as the permanent treaded external sole of the sneaker, the sole plate being uncovered,
  - the removable outersole covering the external sole and the sole plate being in direct contact with the treaded external sole of the sneaker,
  - the permanent treaded external sole of the sneaker adapted for use without the removable outersole,
  - a plurality of sport cleats protruding from the removable outersole; and,
  - a single unbroken continuous elastically deformable band secured to the entire perimeter of the removable outersole,
  - the elastically deformable band sized to removably secure the removable outersole to the permanent treaded sole.
9. (Previously Presented) The athletic footwear of claim 8 further comprising:
  - a support band attached to the elastically deformable band, the support band sized to stretch across a top surface of the athletic footwear,
  - the elastically deformable band secured to the perimeter of the removable outersole.

10. (Previously Presented) The athletic footwear of claim 8 wherein the sport cleats are of at least two different relative heights to each other.
11. (Previously Presented) The athletic footwear of claim 8 wherein the removable rigid planar sole plate is directly coupled to the elastically deformable band,  
the elastically deformable band also defining a toe cap sized to fit over the toe portion of the sneaker,  
the elastically deformable band also having a tapered cross-section ending in a point.
12. (Previously Canceled)
13. (Previously Presented) A method of securing turf knobs to an athletic foot covering, the athletic foot covering being spikeless, having bottom treads, and a top, the method comprising:  
stretching an elastically deformable unbroken and continuous band around the perimeter of the bottom treads of the athletic foot covering,  
the elastically deformable band being shaped in the perimeter outline of the bottom treads of the athletic foot covering,  
the elastically deformable band having an outersole secured to it, the outersole having a top surface and a bottom surface,  
the outersole having a plurality of turf knobs protruding from it the turf knobs being integrally formed on the bottom surface of the outersole and having at least two different heights when measured from the bottom surface; and  
releasing the elastically deformable band.
14. (Previously Presented) The method of claim 13 further comprising:  
lacing a support band over the top of the athletic foot covering, the support band

in structural communication with the elastically deformable band.

15. (Previously Presented) The method of claim 13 wherein the support band is removably coupled to the elastically deformable band.
16. (Previously Presented) The method of claim 13 further comprising:  
stretching a toe cap connected to the elastically deformable band over the top of the athletic foot covering.
17. (Previously Presented) The method of claim 13 wherein the outersole includes a substantially flat and rigid sole plate spanning an arch support of the foot covering, the rigid sole plate being in the same dimension and size as the perimeter of the bottom treads of the athletic foot covering.
18. (Previously Presented) The method of claim 13 wherein the turf knobs are in the shape of a truncated cone having inwardly bowed sidewalls and have at least two different heights relative to one another.
19. (Previously Presented) The method of claim 13 wherein the entire top surface of the outersole is substantially flat and is in direct contact with treads from the foot covering.